REMARKS/ARGUMENTS

The Office Action mailed April 4, 2008 has been received and the Examiner's comments carefully reviewed. Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 2, 11, 14, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 6-11, 15, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al. (U.S. Patent No. 5,966,714) (hereinafter "Huang"). Claims 3, 12, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Kraenzel et al. (U.S. Publication No. 2005/0198144) (hereinafter "Kraenzel"). Claims 4, 5, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Lake (U.S. Patent No. 7,200,638). The Applicants present the following for consideration.

Rejections Under 35 U.S.C. 101

Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In response, Claims 16-20 have been amended to include the term "computer-readable storage medium." The Applicants respectfully request the rejection be withdrawn.

Rejections Under 35 U.S.C. 112, Second Paragraph

Claims 1, 2, 11, 14, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The Applicants have amended the claims to correct the informalities. The Applicants respectfully request the rejection be withdrawn.

Claim Rejections

Claims 1, 2, 6-11, 15, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al. (U.S. Patent No. 5,966,714) (hereinafter "Huang"). Claims 3, 12, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Kraenzel et al. (U.S. Publication No. 2005/0198144) (hereinafter "Kraenzel"). Claims 4, 5, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Lake (U.S. Patent No. 7,200,638).

With regard to Claim 1, the Office Action states that Huang teaches "automatically selecting global address list (GAL) contacts for a user that are unique from the user's personal contacts [column 4 <<line 5>>to column 5 <<line4>>:receiving only a subset of the larger address book I column 6 <<lines 1-14>>| Figure 3e <<item 347>>:selecting contacts based on scanning email addresses from a user's Email folders and archives and determining whether the address is already in the user's personal address book (PAB)]; preparing the GAL contacts [column 7 <<lines 26-32>>| Figure 3e <<item 350>>:preparing the information from the master address book | column 9 <<lines 63-66>>]; and providing the GAL contacts to a device [Figure 3e <<item 355" | column 9 <<lines 63-66>>]." In response, the Applicants have amended the claims to more clearly define the invention.

As amended, Claim 1 recites in part that "automatically selecting global address list (GAL) contacts for a user to include on the device in addition to a user's personal contacts that are already stored on the device; removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user's personal contacts; preparing the GAL contacts; and providing the GAL contacts to the device; wherein the user's personal contacts are treated differently from the provided GAL contacts such that the user's personal contacts are maintained during a synchronization that updates the provided GAL contacts." Among other differences, the cited references do not teach selecting GAL contacts to include on the user's device that are in addition to the user's personal contacts that are already on the device.

Instead, Huang teaches determining all of the contacts to include on the user's device. At col. 4, lines 6-19, Huang states in part that the "method and the apparatus of the present invention involves automatically generating, storing and maintaining a subset of a large address book containing E-mail addresses locally on a client device with limited storage space such as a Smartphone. ... The present invention therefore provides an easy-to-use method for generating a default personal address book automatically and an efficient method for keeping a personal address book synchronized with a master database." At col. 7, lines 57-65 Huang describes that a user selects what fields are to be included in address book that is included on the device. Based on the fields selected, Huang then copies as many of the contacts as it can to the device. In contrast, the present invention treats the user's personal contacts on the device independently from the selected GAL contacts. For example, the GAL contacts selected in the present invention supplement the user's personal contacts and do not replace them. Since the cited references do not teach selecting GAL contacts to include on the user's device that are in

addition to the user's personal contacts that are already on the device, and since the user's personal contacts are treated differently from the selected GAL contacts provided to the device, Claim 1 is proposed to be allowable. Claims depending from Claim 1 are proposed to be allowable as they depend on a valid base claim. Additionally, many of the dependent claims have been amended to more clearly define the invention and more clearly distinguish the claims from the cited references.

Claim 10, as amended, recites in part "receiving an update list from the network containing information to update global address list (GAL) contacts that are unique from a user's personal contacts and are in addition to the user's personal contacts; updating the GAL contacts; storing the updated GAL contacts in the data store; displaying the GAL contacts on the display; and when an edit is made to one of the GAL contacts on the device adding the edited GAL contact to the user's personal contacts on the device." In addition to some of the reasons presented above, Claim 10 is proposed to be allowable since the cited references do not teach converting a GAL contact to a personal contact based on editing the GAL contact on the user's device. For at least this reason, and the reasons presented above, Claim 10 is proposed to be allowable. Claims depending from Claim 10 are proposed to be allowable as they depend on a valid base claim.

Claim 16, as amended, recites in part "automatically selecting global address list (GAL) contacts for a user that are in addition to a user's personal contacts on the device and that are unique from the user's personal contacts from the user's emails." Claim 16 is proposed to be

allowable for at least some of the reasons presented above. Claims depending from Claim 16 are proposed to be allowable as they depend on a valid base claim.

Conclusion

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.

Timothy P. Sullivan
Registration No. 47,981
Direct Dial: 206.342.6254

MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, Minnesota 55402-0903
206.342.6200

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